

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-MAIRE STAWIKOWSKE
and CHRISTIAN HARDY

Appeal 2007-0558
Application 09/940,462
Technology Center 2100

Decided: March 19, 2007¹

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY, and
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-20. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

¹ This appeal was heard on March 6, 2007.

A. INVENTION

Based on the Simple Object Access Protocol ("SOAP"),² the invention on appeal enables automation equipment (10)³ to supervise, display, control, configure, or program at least one remote device (30).⁴ A WEB service (21) or a WEB client (22) interacts with a program (20) of the automation equipment, decodes SOAP messages received (51, 54) via an Internet Protocol ("IP") network (50), and encodes messages to be sent (52, 53) according to the SOAP protocol. A service description document (61), accessible by the remote device, describes the capacities of one or more WEB services in the equipment. (Abs.) By adapting the automation equipment to protocols stemming from the data processing world, assert the Appellants, the equipment can communicate with a remote data processing application without having to develop proprietary gateways or protocols. (Specification 3-4.)

Claim 1, which further illustrates the invention, follows:

1. A communication system on an IP network between an automation equipment comprising:

at least one processing unit capable of running a program to provide automation functions; and

² The SOAP protocol is a protocol allowing information to be exchanged simply in a decentralized environment. It is based on the standardized extensible Markup Language ("XML"). (Specification 3.)

³ A programmable logic controller and a monitoring/control station are examples of "automation equipment." (*Id.* 1.)

⁴ An individual computer, a portable telephone, a personal digital assistant, and a computer server are examples of "remote devices." (*Id.*)

one or more remote devices running a computer program or group of computer programs,

wherein the communications system is based on the Simple Object Access Protocol (SOAP) for the purpose of providing the remote device with supervision, display, control, configuration or programming functions of the automation equipment, and the communications system comprises, in the automation equipment, at least one WEB service or one WEB client which are capable of interacting with the program of the automation equipment, of decoding messages received from the IP network encoded according to the SOAP protocol and of encoding according to the SOAP protocol messages to be sent on the IP network.

B. REJECTIONS

Claims 1-11 and 13-20 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Pub. No. 2002/0032790 ("Linderman"). Claim 12 stands rejected under 35 U.S.C. § 103(a) as obvious over Linderman and Microsoft, *Frequently Asked Questions about XML*.

II. ISSUE

The Examiner makes the following assertions.

The provisional '045, while not explicitly referring to the T-BOX element, discusses corresponding functionality that supports and clearly describes the subject matter. For example, the provisional '045 states that "DaberNet software installed on the server will run a parser filtering out the XML messages intended for the DaberNet, and will translate these messages into the necessary commands." Provisional '045, pg. 3 ¶ 2. The provisional '045 further states that the translation functionality

includes "translation of the XML vocabulary into the necessary SNMP command." Id. (Answer 10.)

The Appellants argue that "there is no discussion in P '045 of any automation equipment including 'at least one WEB service or one WEB client which are capable of interacting with the program of the automation equipment, of decoding messages received from the IP network encoded according to the SOAP protocol and of encoding according to the SOAP protocol messages to be sent on the IP network.'" (Appeal Br. 6.) Therefore, the issue is whether the Examiner has shown that the Provisional '045 supports the functions of the claimed WEB service or WEB client.

In addressing the issue, the Board conducts a two-step analysis. First, we construe the independent claims at issue to determine their scope. Second, we determine whether the construed claims are supported.

III. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983)). Here, claim 1 recites in pertinent part the following limitations:

in the automation equipment, at least one WEB service or one WEB client which are capable of interacting with the program of the automation equipment, of decoding messages received

from the IP network encoded according to the SOAP protocol and of encoding according to the SOAP protocol messages to be sent on the IP network.

Claims 18 and 19 recite similar limitations. Considering all these limitations, the three independent claims require a WEB service or a WEB client to interact with an automation equipment's program, decode messages received via an IP network and encoded according to SOAP, and to encode messages that are to be sent via the IP network according to SOAP.

IV. SUPPORT

"The 35 U.S.C. 102(e) critical reference date of . . . U.S. application publications . . . entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. M.P.E.P § 2136.03.III (8th ed., rev. 3, Aug. 2005).⁵ "[T]he test for sufficiency of support . . . is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

⁵ We cite to the version of the Manual of Patent Examining Procedure in effect at the time of the Examiner's Answer.

Here, the Provisional '045 describes DaberNet as "[a]n object-oriented software package enabling remote control and remote management of any network device." (P. 1, ll. 1-3.) The Examiner has not explained, however, whether he considers DaberNet to constitute a WEB service or a WEB client. Nor has he shown that the software package interacts with an automation equipment's program. Although DaberNet translates XML messages into SNMP commands, (p. 2), the Examiner has not shown that the messages are received via an IP network or encoded according to SOAP. Nor has he shown that DaberNet encodes messages that are to be sent via an IP network according to SOAP. Therefore, we reverse the anticipation rejection of claims 1, 18, and 19 and of claims 2-11, 13-17, and 20, which depend therefrom.

The Examiner does not allege, let alone show, that the addition of Microsoft cures the aforementioned deficiency. Therefore, we reverse the obviousness rejection of claim 12.

V. CONCLUSION

In summary, the rejection of claims 1-11 and 13-20 under § 102(e) is reversed. The rejection of claim 12 under § 103(a) is also reversed.

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REVERSED

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